

REMARKS

Claims 1, 2, 4 through 15 and 29 through 33 are pending in the application. Claims 1, 9, 30 and 32 have been amended and Claims 31 and 33 have been withdrawn. Bases for the amendments may be found throughout the application, claims and drawings as originally filed and as such, no new matter has been entered. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 1, 2, 4 through 15, 29 through 30 and 32 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,692,574 to Terada. Alternatively, Claims 1, 9, 30 and 32 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,738,177 to Schell et al. These rejections are respectfully traversed.

Claim Terminology

Applicant notes that several of the rejections do not appear to be based on structures that can be characterized as being an "overmold" or an "overmold portion". Applicant notes that overmolding is known in the art as molding a plastic material, usually (but not always) a rubber-like elastomer, over a rigid substrate. Accordingly, one of ordinary skill in the art will understand from Applicant's disclosure that the terms "overmold" and "overmold portion" refer to a component that has been formed by molding and cohesively (and substantially permanently) attached to a rigid substrate.

For purposes of illustration only, Applicant is submitting herewith an exemplary structure having an overmold portion. As the Examiner will note, the structure includes a rigid (yellow) plastic material onto which a rubbery (black) thermoplastic elastomer has been

molded. The material that comprises the overmold (i.e., the black portion) is substantially permanently fixed to the structural, rigid (yellow) portion.

As such, elements such as the rubber ring (30) of the Terada reference or the O-ring (76) of the Schell et al. would not be characterized by one of ordinary skill in the art as being an “overmold”. Furthermore, Applicant submits that one of ordinary skill in the art would not assume that an overmold would be interchangeable with such elements. For example, the configuration of the rubber ring (30) of the Terada reference does not appear to be formable through overmolding, as is discussed in greater detail, below.

Rejections based on Terada

The Examiner contends that the ‘574 patent to Terada discloses a portable power tool that employs an “overmold portion 30”, which the Terada reference describes as being a rubber ring rather than an overmold, to form a seal between the “housing portion 3c”, which the Terada reference describes as being a “rear most body section, and a “secondary structure 5”, which the Terada reference describes as being a “hand-held handle”.

As the ‘574 patent to Terada does not mention an overmold or overmolding, Applicant assumes that this rejection is based at least in part on the principals of inherency.

The Federal Circuit has stated:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991).

In this regard, the CCPA has added that “[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (C.C.P.A. 1939) (emphasis in original).

Applicant notes that the rubber ring (30) of the Terada reference is not formed by overmolding and moreover is not substantially permanently affixed to the housing (3). The '574 patent to Terada employs a discrete and independently formed rubber ring (30) that is not molded onto or permanently attached to anything. The rubber ring (30) is assembled onto, rather than cohesively attached to, a cylindrical projection (15) that is formed on a rearmost body section (3c) - see, Col. 5, lines 34 through 36 of the '574 patent to Terada: "[when] the rubber ring 30 is mounted around the projection...". (emphasis added). Moreover, the rubber ring (30) includes an inwardly opening groove (e.g., groove 33 in Figures 3A & 3B, groove 41 in Figure 4A) that is sealed by the outer periphery of the projection (15). If the rubber ring (30) were to be overmolded as alleged by the Office, it is not clear how the inwardly opening groove (33,41) could be formed.

In view of discrete and independent nature of the rubber ring disclosed in the '574 Terada patent, Applicant submits that the '574 patent to Terada lacks an overmolded seal and as such, does not teach or suggest Applicant's invention. Furthermore, the Examiner cannot rely on inherency to support the rejection since he cannot show that the "missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill" in the art. The Examiner, therefore, has not established a prima facie case of anticipation and as such, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of Claims 1, 9, 30 and 32 under 35 U.S.C. §102(b).

Applicant notes that Claims 2, 4 through 8 and 29 depend from Claim 1 and as such, should be in condition for allowance for the reasons set forth for Claim 1, above. Applicant notes, too, that Claims 10 through 15 depend from Claim 9 and as such, should be in condition for allowance for the reasons set forth for Claim 9, above.

Rejections based on Schell et al.

The Examiner has stated that U.S. Patent No. 5,738,177 to Schell et al. discloses a power tool having a structural portion (12) and an overmold portion (14). The overmold portion is made from a resilient material/elastomer (neoprene rubber) and contacts a second structure (42) to effectively dampen vibrations and stresses (see Figures 1B and 19). Schell et al. disclose bumper member (76) for abutting the second structure (18) and limiting movement. Linking members (86) link the bumper (76) and the overmold (14).

The Examiner's comments with respect to the Schell et al. reference appear to be directed only to the dampening of vibrations and stresses and as such, do not appear to be relevant to the subject matter of Claims 1 and 30, which concerns the use of an overmold to form a seal. However, Applicant notes that column 21, lines 21 through 45 appear to describe the overmold (14) as forming a valve. Specifically, the '177 patent to Schell et al. describes the overmold (14) as defining a port (392 - see Figure 1A) that may be punctured by a needle (not shown) to introduce lubrication into the housing (12). Applicant notes, however, that the port (392) is a valve, rather than a seal, and that the needle, when disposed through the port (392), is not a second structure that is "fixedly but removably coupled" to a housing structure. Furthermore, the overmold (14) does not contact the transmission (42) (i.e., the component that the Examiner has identified as being the "second structure") at any point, or any other element for that matter, to form a seal between the housing and that element when the housing and that element are fixedly but removably coupled to one another.

In view of the above, Applicant respectfully submits that the Examiner has not presented a prima facie case of anticipation. In this regard, the '177 patent to Schell et al. does not teach or suggest each and every limitation of Claims 1 and 30 and moreover, the Examiner cannot rely on inherency to fill in the gaps, as inherency "may not be established by probabilities or possibilities" as noted above. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of Claims 1 and 30 under

35 U.S.C. §102(b). Applicant notes too that Claims 2, 4 through 8 and 29 depend from Claim 1 and as such, should be in condition for allowance for the reasons set forth for Claim 1, above.

Applicant further notes that Claim 6 recites that “the overmold portion further includes a bumper member that is coupled to an exterior surface of the molded portion”. Applicant notes that the Schell et al. reference employs reference numeral (76) to designate an O-ring, rather than a portion of the overmold (14). The O-ring is a discrete component and does not form any portion of the overmold (14) nor does the Schell et al. reference describe the O-ring as being permanently coupled to anything. Furthermore, the O-ring (76) is shown in Figures 4 and 7 to abut an interior surface of a removable rear end cap (34). Accordingly, Applicant respectfully submits that the ‘177 patent to Schell et al. does not teach or suggest each and every limitation of Claim 6 and as such, respectfully requests that the Examiner reconsider and withdraw the rejection of Claim 6 under 35 U.S.C. §102(b). Applicant notes, too, that Claims 7 and 8 depend from Claim 6 and as such, should be in condition for allowance for the reasons set forth for Claim 6.

Additionally, Claim 8 recites that “the overmold portion includes a linking member that couples the seal portion to the bumper portion”. Applicant note that the Schell et al. reference employs reference numeral (86) to designate a plurality of screws. The screws (86) of the Schell et al. reference form no part of the overmold (14), nor are they permanently coupled to anything, and as such, the Schell et al. reference fails to teach or suggest each and every limitation of Claim 8. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection to Claim 8 under 35 U.S.C. §102(b).

With regard to Claims 9 and 32, Applicant notes that the overmold (14) of the Schell et al. reference does not contact the transmission (42) (i.e., the element that the Examiner has identified as being a "secondary structure"). Accordingly, the overmold (14) of the Schell et al. reference does not dampen vibrations that are transmitted between the housing (12) and the transmission (42).

As the Examiner knows, a finding of inherency is appropriate where the prior art device necessarily includes the limitations of a claim. *In re King*, 801 F.2d 1324, 231 USPQ 136, 138 (Fed. Cir. 1986). As mentioned above, The Federal Circuit has stated that evidence to "fill" a gap in a reference "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill" in the art. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991). Consequently, "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (C.C.P.A. 1939) (emphasis in original)).

Applicant respectfully submits that the Schell et al. reference does not inherently anticipate Claim 9 of the subject application as the Examiner has not produced evidence that makes "clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill." Accordingly, Applicant submits that the Examiner has not presented a prima facie case of anticipation and therefore respectfully requests that the Examiner reconsider and withdraw the rejection of Claim 9 under 35 U.S.C. §102(b). Applicant notes, too, that Claims 10 through 15, 24 and 26 depend from Claim 9 and as such, should be in condition for allowance for the reasons set forth for Claim 9, above.

Applicant further notes that Claim 13 recites that “the overmold portion further includes a bumper member that is coupled to an exterior surface of the structural portion”. Applicant notes that the Schell et al. reference employs reference numeral (76) to designate an O-ring, rather than a portion of the overmold (14). Furthermore, the O-ring (76) is shown in Figures 4 and 7 to abut an interior surface of a removable rear end cap (34). Accordingly, Applicant respectfully submits that the ‘177 patent to Schell et al. does not teach or suggest each and every limitation of Claim 13 and as such, respectfully requests that the Examiner reconsider and withdraw the rejection of Claim 13 under 35 U.S.C. §102(b). Applicant notes, too, that Claims 14 and 15 depend from Claim 13 and as such, should be in condition for allowance for the reasons set forth for Claim 13.

Additionally, Claim 14 recites that “the overmold portion includes a linking member that couples the seal portion to the bumper portion”. Applicant note that the Schell et al. reference employs reference numeral (86) to designate a plurality of screws. The screws (86) of the Schell et al. reference form no part of the overmold (14) and as such, the Schell et al. reference fails to teach or suggest each and every limitation of Claim 14. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection to Claim 14 under 35 U.S.C. §102(b).

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that

personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: 3 February 2004

By:

A handwritten signature in black ink, appearing to read 'Michael D. Zalobsky', written over a horizontal line.

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